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23910	7590	12/24/2003	EXAMINER	
FLIESLER DUBB MEYER & LOVEJOY, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/854,163

Applicant(s)

ENG, MAY D.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities: the last line of page 26, the phrase "Figure 13" should be "Figure 14".

Appropriate correction is required.

***Claim Objections***

2. Claims 1, 19, 26 and 33 are objected to because of the following informalities:
  - a) In line 4 of claim 1, the phrase "said software program" should be "said licensed software program"; In lines 4-5 of claim 1, the phrase "said network" should be "said distributed computer network; In line 6 of claim 1, the phrase "said network" should be "said distributed computer network; In line 7 of claim 1, the phrase "said network" should be "said distributed computer network;
  - b) In line 7 of claim 19, the phrase "said software program" should be "said licensed software program"; In lines 7-8 of claim 19, the phrase "said network" should be "said distributed computer network; In line 9 of claim 19, the phrase "said network" should be "said distributed computer network; In line 10 of claim 19, the phrase "said network" should be "said distributed computer network;
  - c) In line 4 of claim 26, the phrase "said software program" should be "said licensed software program"; In line 5 of claim 26, the phrase "said network" should be "said distributed computer network; In line 6 of claim 26, the phrase "said network" should be "said distributed computer network; In line 7 of claim 26, the phrase "said network" should be "said distributed computer network;

d) In line 7 of claim 33, the phrase "said software program" should be "said licensed software program"; In line 7-8 of claim 33, the phrase "said network" should be "said distributed computer network; In line 9 of claim 33, the phrase "said network" should be "said distributed computer network; In line 10 of claim 33, the phrase "said network" should be "said distributed computer network. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said nodes" in line 2. There is insufficient antecedent basis for this limitation in the claim.

A claim 3 is rejected for incorporating the errors of its respective dependent claim 2 by dependency.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-8, 10, 13-14, 17, 19, 23, 25-26, 30, 32-33, 37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivera et al., U. S. Patent 6,056,786.

As to claim 1, Rivera teaches a machine-implemented method for managing software licenses in a distributed computer network having a maximum number of said licenses for use with a licensed software program, comprising the steps of (abstract and column 3 lines 31-35 and column 8 lines 35-43; *specifically, "a maximum number of said license for use" is interpreted as the number of client licenses in Rivera's teaching*):

- a) Counting users of said software program at a plurality of nodes of said network to obtain counts of software licenses in use by each node (column 3 lines 31-35 and column 6 lines 13-16, 51-57 and column 8 lines 21-23 and Figs. 3, 5B);
- b) Transmitting said counts to a master node (*item 64 in Fig. 3*) of said network (column 6 lines 13-16, 51-57 and Fig. 3);
- c) Calculating a total number of software users on said network, said calculating step uses said counts (column 6 lines 51-57);
- d) Evaluating a license allocation condition using said total number of users to obtain a license allocation result (column 6 lines 51-57 and column 8 lines 35-43 and Figs. 3, 5B);
- e) Responding said license allocation result if said license allocation condition is met (column 8 lines 35-43; *specifically, "said license allocation condition is met" is interpreted as is the number of the software users exceed the number of client licenses*).

As to claim 5, Rivera further teaches wherein:

- a) Said condition is an warning condition (column 8 lines 39-66),
- b) Said responding step comprises the step of displaying a warning message (column 8 lines 39-66 and Fig. 1).

As to claim 6, Rivera further teaches wherein:

- a) Said condition is an information condition (column 8 lines 39-66),
- b) Said responding step comprises the step of displaying an information message (column 8 lines 39-66 and Fig. 1).

As to claims 7, 23, 30 and 37, Rivera further teaches wherein:

- a) Said condition is a threshold value (column 8 lines 35-43; *specifically, "a threshold value" is interpreted as the number of client licenses*),
- b) Said evaluating step compares said total users to said threshold value (column 8 lines 35-43),
- c) Said condition is met if said total users is at least equal to said threshold (column 8 lines 35-43).

As to claim 8, Rivera further teaches wherein:

- a) Said evaluating step compares said total users to said maximum number of licenses (column 8 lines 35-43),
- b) Said condition is met if said total users comprises at least a minimum percentage of said maximum number of licenses (column 8 lines 35-43; *specifically, "a minimum percentage of said maximum number of licenses"*

*corresponds to 100% of the number of client licenses or exceed the number of the client licenses in Rivera's teaching).*

As to claim 10, Rivera teaches said threshold is 100 percent of said maximum number of licenses (column 8 lines 35-43).

As to claim 13, Rivera teaches said threshold is at least equal to said maximum number of licenses (column 8 lines 35-43).

As to claim 14, said transmitting step transmits said counts asynchronously is taught by Rivera as transmitting said counts whenever the license usage occurs (column 6 lines 13-16, 51-57 and Fig. 3-4).

As to claims 17, 25, 32 and 39, Rivera further teaches repeating said calculating and evaluating steps periodically (column 7 lines 3-64 and Figs. 5A-5B).

As to claim 19, Rivera teaches an apparatus comprising:

- a) A memory, said memory adapted to store program code (column 9 lines 16-18 and Fig. 1);
- b) A processor in communication with said memory, said program code capable of programming said processor to perform a method for managing software licenses in a distributed computer network having a maximum number of said licenses for use with a licensed software program, the method comprising the steps of (abstract and column 3 lines 31-35 and column 8 lines 35-43 and Fig. 1; *specifically, "a maximum number of said license for use" is interpreted as the number of client licenses in Rivera's teaching*);

- i) Counting users of said software program at a plurality of nodes of said network to obtain counts of software licenses in use by each node (column 3 lines 31-35 and column 6 lines 13-16, 51-57 and column 8 lines 21-23 and Figs. 3, 5B);
- ii) Transmitting said counts to a master node (*item 64 in Fig. 3*) of said network (column 6 lines 13-16, 51-57 and Fig. 3);
- iii) Calculating a total number of software users on said network, said calculating step uses said counts (column 6 lines 51-57);
- iv) Evaluating a license allocation condition using said total number of users to obtain a license allocation result (column 6 lines 51-57 and column 8 lines 35-43 and Figs. 3, 5B);
- v) Responding said license allocation result if said license allocation condition is met (column 8 lines 35-43; *specifically, "said license allocation condition is met" is interpreted as is the number of the software users exceed the number of client licenses*).

As to claim 26, Rivera teaches an apparatus for managing software licenses in a distributed computer network having a maximum number of said licenses for use with a licensed software program, comprising (abstract and column 3 lines 31-35 and column 8 lines 35-43; *specifically, "a maximum number of said license for use" is interpreted as the number of client licenses in Rivera's teaching*):

- a) Means for counting users of said software program at a plurality of nodes of said network to obtain counts of software licenses in use by each node (column 3



lines 31-35 and column 6 lines 13-16, 51-57 and column 8 lines 21-23 and Figs. 3, 5B);

b) Means for transmitting said counts to a master node (*item 64 in Fig. 3*) of said network (column 6 lines 13-16, 51-57 and Fig. 3);

c) Means for calculating a total number of software users on said network, said calculating step uses said counts (column 6 lines 51-57);

d) Means for evaluating a license allocation condition using said total number of users to obtain a license allocation result (column 6 lines 51-57 and column 8 lines 35-43 and Figs. 3, 5B);

e) Means for responding said license allocation result if said license allocation condition is met (column 8 lines 35-43; *specifically, "said license allocation condition is met" is interpreted as is the number of the software users exceed the number of client licenses*).

As to claim 33, Rivera teaches a processor readable storage medium comprising (Fig. 1):

a) Processor readable program code embodied on said processor readable storage medium, said processor readable program code for programming a processor to perform a method for managing software licenses in a distributed computer network having a maximum number of said licenses for use with a licensed software program, the method comprising the steps of (abstract and column 3 lines 31-35 and column 8 lines 35-43 and column 9 lines 16-18 and

Fig. 1; specifically, *"a maximum number of said license for use" is interpreted as the number of client licenses in Rivera's teaching*);

- i) Counting users of said software program at a plurality of nodes of said network to obtain counts of software licenses in use by each node (column 3 lines 31-35 and column 6 lines 13-16, 51-57 and column 8 lines 21-23 and Figs. 3, 5B);
- ii) Transmitting said counts to a master node (*item 64 in Fig. 3*) of said network (column 6 lines 13-16, 51-57 and Fig. 3);
- iii) Calculating a total number of software users on said network, said calculating step uses said counts (column 6 lines 51-57);
- iv) Evaluating a license allocation condition using said total number of users to obtain a license allocation result (column 6 lines 51-57 and column 8 lines 35-43 and Figs. 3, 5B);
- v) Responding said license allocation result if said license allocation condition is met (column 8 lines 35-43; specifically, *"said license allocation condition is met" is interpreted as is the number of the software users exceed the number of client licenses*).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 9, 11-12, 15-16, 18, 20, 24, 27, 31, 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U. S. Patent 6,056,786.

As to claims 2, 20, 27 and 34, Rivera teaches the steps of:

- a) Performing a sanity scan on at least one subset of said nodes (column 6 lines 13-27 and column 7 line 3 – column 9 line 7 and Figs. 3, 5A-5B; *specifically, “a sanity scan” is interpreted as the monitoring routine*);
- b) Generating a scan result message, transmitting said scan result message (column 8 line 35 – column 9 line 7 Figs. 3, 5A-5B; *specifically, the scan result message is interpreted as the message indicates there are insufficient number of licenses for the users*).

Rivera does not explicitly teach said transmitting step transmits said scan result message with at least one said counts. However, Rivera teaches if it is determined there are insufficient number of licenses for the users, checking with the users at a later date for determining if the requisite additional licenses have been purchased (column 8 line 35 – column 9 line 7) . It would have been obvious to one of ordinary skill in the art to allow the transmitting step in Rivera’s teaching to include transmitting the scan result message along with at least one said counts because this would allow the network for better determining the number of licenses need to be purchased by the users.

As to claims 9 and 11-12, Rivera teaches said threshold is 100 percent of said maximum number of licenses (column 8 lines 35-43). Rivera does not specifically teach said threshold is 110% or 90% of said maximum number of licenses, or said threshold is at least 5 licenses greater than said maximum number of licenses. However, Rivera

teaches sending warning messages if the number of the users exceed to the number of client licenses, and allowing the users to continue the license usages during a predetermined grace period (column 8 line 39 – column 9 line 7). It would have been obvious to one of ordinary skill in the art to allow the threshold in Rivera's teaching to be set to different values so that the users can be better notified based on various usage conditions, such as approaching or exceeding the maximum number of licenses.

As to claims 15, 24, 31 and 38, Rivera further teaches repeating said performing step periodically (column 7 lines 3-30).

As to claims 16 and 18, Rivera further teaches said period is a designated period such as fifteen minutes (column 3-30). Rivera does not explicitly teach said period is two minutes or five minutes. It would have been obvious to one of ordinary skill in the art to allow the period in Rivera's teaching to be set at various time intervals (i.e. two minutes, five minutes) based on individual specification so that the number of users can be more efficiently and accurately counted.

9. Claims 3-4, 21-22, 28-29 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U. S. Patent 6,056,786 in view of Bains et al., U. S. Patent 5,579,222.

As to claims 3, 21, 28 and 35, Rivera further teaches deallocating any licenses allocated to users of any of said nodes if the users do not purchase the requisite additional licenses within a predetermined grace period (column 8 line 48 – column 9 line 7).

Rivera does not specifically teach checking whether one of said scan result message has been received from all of said nodes; and deallocating any licenses to users of any of said nodes from which a scan result message has not been received. However, this matter is taught by Bains as checking the connection between the nodes and the license server, and no license is granted to said nodes if said nodes lost connection from the license server or if said nodes do not entitle to temporary user licenses (column 8 lines 1-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Rivera's teaching to include the features of checking the message responses from all of said nodes, and deallocating any licenses to users of any of said nodes from which the scan result message has not been received because this would ensure the licenses are granted only to the recognized nodes; thus, the licenses would be better protected from unauthorized/unrecognized usages.

As to claims 4, 22, 29 and 36, Rivera further teaches wherein:

- a) Said condition is the number the users exceeds number of client licenses (column 8 lines 39-43),
- b) Said responding step comprises the steps of: measuring a license lockout grace period; and initiating a license lockout if said grace period is exhausted (column 8 line 39 – column 9 line 7).

Rivera does not explicitly teach said condition is an error condition. However, Bains teaches evaluating a license allocation condition, and said condition including an error condition (column 8 lines 53-56). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to allow the license allocation condition in Rivera' teaching to include an error condition for better protecting the licenses from illegal usages.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lassers (U. S. Patent 5,343,526) discloses establishing licensor changeable limits on shared software usage without the licensor having access to the system on which the shared software is running.

Coley et al. (U. S. Patent 5,790,664) discloses automatically tracking use of a software and also for determining whether the software is validly licensed and enabling or disabling the software accordingly.

Misra et al. (U. S. Patent 6,189,146) discloses a license generator located at a licensing clearinghouse and at least one license server and multiple clients located at a company or entity.

Glassman et al. (U. S. Patent 6,453,305) discloses enforcing a license agreement for content on an open network by restricting the number of consumer that can concurrently access the content.

Barritz et al. (EP 0 852 349 A2) discloses collating, correlating and redistributing information about the use of proprietary products including copyrighted works and licensed software products at various computer sites.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final

Communications labeled "BOX AF")

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
December 6, 2003

